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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,209	01/22/2004	John S. Watanabe	093013-0303858	8095
27498	7590	07/26/2004	EXAMINER	
PILLSBURY WINTHROP LLP 2475 HANOVER STREET PALO ALTO, CA 94304-1114			KAUFFMAN, BRIAN K	
			ART UNIT	PAPER NUMBER
			3765	

DATE MAILED: 07/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

YW

Office Action Summary	Application No. 10/764,209	Applicant(s) WATANABE, JOHN S.	
	Examiner Brian K Kauffman	Art Unit 3765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-112 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 55 and 112 is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-21, 30, 39-41, 43-44, 46-54, 56-68, 70-77, 86-87, 96-98, 100-101 and 103-111 is/are rejected.
- 7) ☒ Claim(s) 13, 22-29, 31-38, 42, 45, 69, 78-85, 88-95, 99 and 102 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The use of the trademarks Chako Pen, Pattern Aid Designing, Adobe Photoshop, and Adobe Illustrator has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, 63, and 64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8, 9, 63, and 64 contain the trademark/trade name Chako Pen. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used

properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a marking device and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 11-12, 14-21, 30, 39-41, 43-44, 46-54, 56-62, 66-68, 70-77, 86-87, 96-98, 100-101, and 103-111 are rejected under 35 U.S.C. 102(b) as being anticipated by Minsky (5,956,525). In regard to claim 1, Minsky discloses a system for producing a custom-made garment using specification data for a customer comprising: a base pattern capable of accepting inspection marks and mark lines (fig.5), the mark lines being in accordance with design and fit preferences of the customer; a scanning system for producing an image of the marked base pattern (col. 14, lines 10-16); and a computer system that receives the image of the marked base pattern from the scanning system and determines the locations of the inspection marks and the mark lines therefrom.

In regard to claim 56, Minsky discloses a custom-made garment using specification data for a customer, the method comprising the steps of: providing a base pattern capable of accepting inspection marks and mark lines (fig. 5), the mark lines being in accordance with design and fit preferences of the customer; operating a

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scanning system for producing an image of the marked base pattern (col.14, lines 10-16); and utilizing a computer system that receives the image of the marked base pattern from the scanning system and determines the locations of the inspection marks and the mark lines therefrom.

In regard to claim 109, Minsky discloses a method for creating specification data for use in creating a custom-made garment, the method comprising of: marking a base pattern to contain inspection marks and mark lines (fig. 5), the mark lines being in accordance with preferences of the customer; producing an image of the marked base pattern using a scanning system (col. 14, lines 10-16); and receiving the image of the marked base pattern from the scanning system with a computer system, wherein the computer system is adapted to generate specific data from the image, the specification data representing a design of the marked base pattern and placement and location of the inspection marks.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minsky (5,956,525) in view of Park et. al. (5,768,135). Minsky does not disclose a system which requires the highly visible medium to be erasable and naturally disappearing. Park et. al. does disclose a system which requires the highly visible medium to be erasable and naturally disappearing (col. 5, lines 7-10). Requiring the medium to be erasable and naturally disappearing allows the try-on garments to be used more than once. It would have been obvious to one having ordinary skill in the art at the time the invention was made to require the highly visible medium to be erasable and naturally disappearing as suggested by Park et. al. so that the try-on garments may be used more than once.

Allowable Subject Matter

Claims 13, 22-29, 31-38, 42, 45, 69, 78-85, 88-95, 99, and 102 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 55 and 112 are allowed.

The following is an examiner's statement of reasons for allowance: claim 13 specifically requires the specification data to utilize a three-dimensional coordinate

system. Claims 22 and 23 specifically require that the automated cut and sew machine include a recognition camera and an optional ink jet head attachment. Claims 24 and 25 specifically require the cutting system to be adapted to, prior to cutting the fabric, mark the fabric using the specification data and verify the accuracy of the marked fabric using the placement and location of the inspection marks. Claims 26-29, 32-37, 42, and 45 specifically require the cutting system to be adapted to determine a position and angle of the inspection marks relative to the specification data using a calculated position of the fabric within the cutting system. Claim 31 specifically requires the sewing system to be adapted to inspect the custom-made garment using the placement and location of the inspection marks. Claim 38 specifically requires the scanning system to include a transparent holder for holding the base pattern during scanning. Claim 55 specifically requires a transparent holder for holding the favorite garment in a two dimensional manner. Claim 69 specifically requires the specification data to utilize a three-dimensional coordinate system. Claims 78 and 79 specifically require the automated cut and sew machine to include a recognition camera and an optional ink jet head attachment. Claims 80 and 81 specifically require the cutting system to be adapted to, prior to cutting the fabric, mark the fabric using the specification data and verify the accuracy of the marked fabric using the placement and location of the inspection marks. Claims 82-85, 88-94, 99, and 102, specifically require the cutting system to be adapted to receive the x-y coordinate data, cut fabric according to the received x-y coordinate data, and inspect the cut fabric using the inspection mark to re-connect imaginary x-y axes and associated imaginary x-y grid over the cut fabric. Claim 95 specifically

requires the scanning system to include a transparent holder for holding the base pattern during scanning. Claim 112 specifically requires providing a transparent holder for holding the favorite garment in a two-dimensional manner.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Kauffman whose telephone number is (703)605-4933. The examiner can normally be reached on M-F every week.

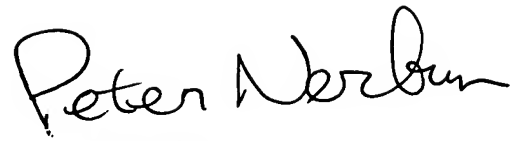
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703)305-1025. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BKK

A handwritten signature in black ink, reading "Peter Nerbun". The signature is written in a cursive style with a large initial "P" and a stylized "N".

Peter Nerbun
Primary Examiner